

DETAILED ACTION

Applicants' amendments and remarks filed December 15, 2009, are responsive to the office action mailed September 16, 2009. Claims 1-15 were previously withdrawn. Claims 16, 19, 21-22, and 24-25 are amended and claim 20 is cancelled. Replacement drawing figures 13-33 and 37 have been filed replacing original drawing figures 13-33 and 37. Claims 16-19 and 21-25 are therefore currently pending and examined in this office action.

Priority

1. **Should applicant desire to obtain the benefit of Japanese application 2002-264772, filed September 10, 2002, under 35 U.S.C. 119(a)-(d), a certified English translation must be submitted.** 37 CFR 41.154(b) and 41.202(e). Failure to provide a certified translation may result in no benefit being accorded for the non-English application. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Response to Amendment

Pertaining to objection to drawings in the previous office action

Drawings figures 13-33 and 37 were objected to because lead lines were missing. The replacement drawing figures have corrected this issue and the objection is withdrawn.

Pertaining to rejection under 35 USC 112 in the previous office action

Claim 22 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim contained the trademark/trade name "Bluetooth." This has been amended to refer to the bluetooth protocol rather than merely "Bluetooth technology." Examiner understands "bluetooth protocol" to be referring to a commonly known industry standard that would be understood by one of ordinary skill in the art. This rejection is therefore withdrawn.

Pertaining to rejection under 35 USC 101 in the previous office action

Claims 24 and 25 were rejected as being directed to non-statutory subject matter. Applicants have amended the claims, but apparently because they believe the amendments are satisfactory they do not argue on their behalf. The amendment of claim 24 is insufficient for the same reasons it was originally rejected. As stated in the previous office action, "In claim 24 the only steps performed by a specific apparatus are the transmission (outputting), receipt and accumulation (gathering) of information. The selecting step is the only significant, limiting step but it recites no tie to a machine or

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apparatus.” See office action mailed September 16, 2009, page 9. Despite the amendment of the claim, the described situation remains the same.

The amendment of claim 25 has merely resulted in a different explanation for the rejection, as further noted below.

Response to Arguments

Pertaining to rejection under 35 USC 112 in the previous office action

Applicants’ arguments, see remarks, filed December 15, 2009, with respect to claims 18-19 have been fully considered and are persuasive. Claims 18-19 were rejected because the element “analyzing means for analyzing audio information” is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph, but the written description failed to sufficiently disclose the corresponding structure, material, or acts for the claimed function. In accord with the rejection, if applicants are of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicants are required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

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(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Applicants have stated on the record the corresponding structure, material, or acts, implicitly or inherently set forth in the written description of the specification, perform the claimed function in their remarks at pages 13-14. This rejection of claims 18-19 has therefore been withdrawn.

Pertaining to rejection under 35 USC 102 in the previous office action

Applicants' arguments filed December 15, 2009, have been fully considered but they are not persuasive. Applicants have added the negative limitation "without registering the user information with the second information processing apparatus," and argue that the prior art does not disclose this feature. Unfortunately, the only thing a reference needs do to anticipate "without registering the user information with the second information processing apparatus" is simply disclose a second information processing apparatus and remain silent with regard to registering user information with it. In other words, if the reference does not disclose registering user information on a second apparatus, then it anticipates this feature, unless the registration of the information is inherent. Unfortunately, it is not inherent here because the claims are still only directed to one user and the user's information is still only registered with the first apparatus. The fact that a second and additional apparatuses are also connected to the system (also called an 'information processing apparatus') for the purpose of data

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accumulation, does not change the way the invention functions with regard to each user. Applicants appear to have made a leap in logic without reconciling their reasoning with the way the inventions (both present and prior art) actually function.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 24-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With regard to claim 24, the first step in determining whether a method claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products," while a "process" consists of a series of steps or acts to be performed. For purposes of section 101, a "process" has been given a specialized, limited meaning by the courts. Based on Supreme Court precedent and recent Federal Circuit decisions, a process must (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process. See *In re Bilski*, 2008 U.S. App. LEXIS 22479. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

In order to qualify as a statutory process, therefore, claims should positively recite the machine or apparatus to which they are tied, for example by identifying the machine or apparatus that accomplishes the method steps, or they should positively recite the particular article that is being transformed, for example by identifying the material that is being changed to a different state. The mere manipulation of data is not transformation of a particular article. There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

In claim 24 the only steps performed by a specific apparatus are the transmission (outputting), receipt and accumulation (gathering) of information. The selecting step is the only significant, limiting step but it recites no tie to a machine or apparatus.

Claim 25 is drawn to a computer readable storage medium having embedded therein instructions...." The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When

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the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 USC 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 USC 101*, Aug. 24, 2009; p. 2.

Claims reciting a musical composition, literary work, compilation of data, signal, or legal document (e.g., an insurance policy) per se do not appear to be a process, machine, manufacture, or composition of matter. See, e.g., *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) ("A transitory, propagating signal like Nuijten's is not a process, machine, manufacture, or composition of matter.' ... Thus, such a signal cannot be patentable subject matter.").

A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 USC 101 by adding the limitation "non-transitory" to the claim. Cf. *Animals -Patentability*, 1077 Off. Gaz. Pat. Office 24 (April 21, 1987) (suggesting that applicants add the limitation "non-human" to a claim covering a multi-cellular organism to avoid a rejection under 35 USC 101).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 16-19 and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by DeLorme (Paper No. 20090910; US Patent No. 5,948,040).

DeLorme teaches all the limitations of claims 16-19 and 21-25. For example, DeLorme teaches an information processing apparatus that selects presentation information to be presented to a user by a first information processing apparatus from among accumulated information received from another information processing apparatus based on user information. DeLorme also discloses mobile users including GPS-linked users accessing the information via wireless communication units.

DeLorme further discloses:

- first communication means for receiving user information: which is the information concerning the user, from the first information processing apparatus (see at least abstract, figs. 2, 7-9; column 2 lines 1-19, column 10 lines 19-58); includes information concerning the longitude and latitude of a location of the user (see at least fig. 8, column 8 lines 22-33, column 21 line 58 – column 22 line 6); audio information spoken by the user acquired by the other first information processing apparatus and analyzing means for analyzing the audio information (see at least fig. 7, column 14 lines 53-65, column 15 lines 14-32, column 16 lines 32-59, column 23 line 64 – column 24 line 28); performs communication with the other first information processing apparatus in compliance with bluetooth protocol (see at least abstract, fig. 9, column 10 lines 34-58, column 71 line 60 – column 72 line 43.);

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- second communication means for receiving accumulated information:

accumulated in another second information processing apparatus from the second information processing apparatus without registering the user information with the second information processing apparatus (see at least column 1 lines 26-47, column 3 lines 53 – column 4 line 14, column 10 lines 34-58, column 25 line 66 –column 26 line 28, column 31 lines 15-41, column 40 lines 16-56.

Please note: “the user information” is understood as the same user information registered with the first information processing apparatus); includes article information of articles sold in a shop (see at least column 7 lines 9-53, column 10 line 59 – column 11 line 25, column 14 lines 19-42);

- selecting means for selecting, based on the user information: presentation information, which is information to be presented to the user from the accumulated information, and the analysis result in the analyzing means wherein the first communication means transmits the presentation information selected by the selecting means to the first information processing apparatus (see at least abstract, column 1 lines 27-46, column 4 lines 15-42, column 10 lines 34-58, column 15 lines 33-67, column 18 lines 40-57); accumulated information includes information of articles sold in a shop (see at least abstract, figs. 7-8, column 1 lines 29-46, column 4 lines 1-15, column 10 lines 1-18); selecting means selects, based on user information, article information associated with an article expected to be desired by the user from the information of articles sold in the shop (see at

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least abstract, column 7 lines 9-53, column 10 line 59 – column 11 line 25, column 14 lines 19-42);

- first communication means transmits the article information: of the selected article to the first information processing apparatus (see at least abstract, figs. 2, 7-9; column 2 lines 1-19, column 10 lines 19-58);
- determining means for determining: whether the user is present in the shop wherein the selecting means selects the article expected to be desired by the user from the articles sold in the shop in which the user is present, determined by the determining means (see at least abstract, figs. 1-3, 5, 7-8, column 10 lines 34-58);
- storage means for storing the user information: received by the first communication means and the accumulated information received by the second communication means (see at least fig. 9, column 4 lines 15-42, column 7 line 65 – column 8 line 22);

Pertaining to method claim 24

Rejection of claim 24 is based on the same rationale noted above.

Pertaining to computer readable medium claim 25

Rejection of claim 25 is based on the same rationale noted above. In addition, DeLorme discloses a computer readable medium having embedded therein instructions (see at least column 4 lines 43-61, column 35 lines 34-60, column 62 line – column 63 line 32).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

This application contains claims 1-15 drawn to an invention nonelected without traverse in the reply filed on July 16, 2009. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM LEVINE whose telephone number is (571)272-8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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